

REMARKS

Applicant requests that this Amendment be entered prior to examination of this application. The subject matter added to the claims is supported in the disclosure, inter alia, in FIGS. 1-7, and the claims as originally submitted and is therefore not new matter. In view of the foregoing, applicants believe that claims 1-46 are all allowable and the same is respectfully requested.

Regarding claims 44, 45, and 46, applicants respectfully submit in good faith that claimed aspects of the invention are unanticipated, nonobvious and allowable. Anticipation requires a showing that "each element of the claim in issue is found, either expressly or under principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice." Minnesota Mining and Manufacturing v. Johnson & Johnson, 24 U.S.P.Q 2d 1321, 1326 (Fed. Cir. 1992).

It is unknown from a reading of the Kirshner drawing what exactly would be revealed by rotating the depicted stem ninety degrees to bring the medial lip under surface into view, in contrast to applicants' disclosure which includes the clear detail of FIG. 1A and corresponding written description. Such a view, or any disclosure corresponding to it, is unavailable in the mere side-view profile drawing of Kirshner, leaving any three dimensional environment of the medial lip undersurface unknown, and

subject to speculation and hindsight analysis. Regardless of the two-dimensional, side-view profile of Kirshner, the actual medial-lip under surface exists in the context of a three-dimensional environment that may comprise one of any number of structural possibilities. Without some illustration or description in Kirshner to show the three dimensional environment, as in the manner of FIG. 1A of applicants' application, it would be speculation to presume whether the angle formed between the medial lip undersurface and the long axis of the stem would be greater than ninety degrees in the Kirshner prosthesis.

Claims 44-46 are therefore not anticipated because the Kirshner drawing does not expressly identify the subject matter "an under surface of a terminal portion of a lip of said medial section forms an angle with the long axis of the stem means which is greater than ninety degrees." The drawing would need to include something more, such as an angle symbol in reference to defined angle lines that are clearly greater than ninety degrees, or some other such specific teaching.

Furthermore, the Kirshner drawing does not expressly illustrate the multi-dimensional concept of the subject matter "an under surface of a terminal portion of a lip of said medial section forms an angle with the long axis of the stem means which is greater than ninety degrees." The Kirshner drawing is a mere profile, and does not reveal the structure of the undersurface of

a terminal portion of the lip. Ex parte Levy, 17 U.S.P.Q. 2d 1461, 1462 (Bd Pat App & Inter 1990), "Moreover, it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."

In addition to not expressly depicting or illustrating the element in question, Kirshner also does not inherently disclose the subject matter "an under surface of a terminal portion of a lip of said medial section forms an angle with the long axis of the stem means which is greater than ninety degrees." "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' In re Robertson, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999) (citations omitted) (italics added).

Because the Kirshner reference fails to show the undersurface of the terminal portion of the lip or discuss this feature in the written text, the angle of the under surface is not necessarily present in the Kirshner reference. It is possible that the Kirshner prosthesis could contain an indentation in the undersurface of the terminal portion of the lip such that the profile would appear as pictured in the Kirshner reference, but such that the angle of the undersurface with respect to the long axis would be less than 90 degrees. The requisite angle is therefore not necessarily present as required by the above

authority for inherency, so the Kirshner drawing does not inherently disclose the invention. In re Robertson, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999) (citations omitted), "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

Regarding obviousness, the invention of claims 44-46 is also not obvious when Kirshner is combined with the other prior art references, since Kirshner provides no suggestion for an undersurface of a terminal portion of a lip of the medial section to form an angle with the long axis of the stem means which is greater than ninety degrees. Kirshner not only fails to disclose the subject matter in diagrams or written text, but is also silent as to the advantages of an undersurface of the terminal lip forming an angle with the long axis of greater than ninety degrees. The present invention allows incremental micro-motion that permits the prosthesis to gradually, ever so slightly, settle into a position of stability (see page 13, lines 4-16 of the specification).

The Federal Circuit has repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teaching of the prior art. See, e.g., Grain Processing Corp. v. American-Maize Prods. Co., 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

Applicants submit that this is a classic case where a reference must have some clear and specific suggestion or indication of the presence of the feature claimed, yet the Kirshner reference lacks such specificity. It is understandable that the Patent Office may initially choose to isolate certain elements in a patent and claim, with the benefit of hindsight, that the element or elements are present in the Kirshner drawing. However, in the absence of a specific suggestion, such a practice is tantamount to the Patent Office impermissibly using applicant's teachings to hunt through the prior art references for the claimed elements and concoct them in combination without suggestion. In re Laskowski, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). The Office must provide specific, concrete documentation of the feature in the prior art, or some suggestion thereof. See Id.

The law cited above, and other similar authority, prohibit such hindsight speculation to be relied upon for a finding of unpatentability. Indeed, it would take a retrospective view of the Kirshner drawing, in light of applicants' discovery as defined in claims 44-46, to enable one of ordinary skill to obtain the concept of the claimed subject matter "an under surface of a terminal portion of a lip of said medial section forms an angle with the long axis of the stem means which is greater than ninety degrees", an undertaking which is clearly prohibited by law. In re Newell, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989).

If any impediment to the allowance of these claims remains after entry of this Amendment, and such impediment could be alleviated during a telephone interview, the Examiner is invited to initiate the same.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0836.

DATED this 6 day of May, 2002.

Respectfully submitted,



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